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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/041,574	01/10/2002	Jian Ni	PF375P1D1	7011

22195 7590 04/08/2003

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EXAMINER

O HARA, EILEEN B

ART.UNIT	PAPER NUMBER
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1646

DATE MAILED: 04/08/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application N .	Applicant(s)	
	10/041,574	NI ET AL.	
	Examin r	Art Unit	
	Eileen O'Hara	1646	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 1-24 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-13, 15-19 and 23, in so far as they are drawn to polynucleotides of TR9, vectors, host cells and a method for producing a polypeptide recombinantly, classified in class 536, subclass 23.5, class 435, subclasses 320.1, 252.3 and 69.1, for example.
- II. Claim 14, in so far as it is drawn to polynucleotide of SEQ ID NO: 6, classified in class 536, subclass 23.5.
- III. Claim 14, in so far as it is drawn to polynucleotide of SEQ ID NO: 7, classified in class 536, subclass 23.5.
- IV. Claim 14, in so far as it is drawn to polynucleotide of SEQ ID NO: 8, classified in class 536, subclass 23.5.
- V. Claim 14, in so far as it is drawn to polynucleotide of SEQ ID NO: 9, classified in class 536, subclass 23.5.
- VI. Claim 14, in so far as it is drawn to polynucleotide of SEQ ID NO: 10, classified in class 536, subclass 23.5.
- VII. Claims 20, 21 and 24, drawn to TR9 polypeptides, classified in class 530, subclass 350.
- VIII. Claim 22, drawn to antibodies to TR9, classified in class 530, subclass 388.22, for example.

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2. The inventions are distinct, each from the other because of the following reasons:

Invention I is distinct and independent from each of inventions II-VI in that the nucleic acid molecules of each group of inventions have unique nucleotide sequences that are different and require separate and non-coextensive searches. Applicant on page 13 of the specification states that the nucleic acids of inventions II-VI are related to portions of the nucleotide sequence of SEQ ID NO: 1, however, it is not clearly defined how they are related, and they appear to be different and require separate sequence searches and consideration.

Inventions II-VI are also distinct and independent from each other in that the nucleic acid molecules of each group of inventions have unique nucleotide sequences that are different and require separate and non-coextensive searches. Applicant on page 13 of the specification states that the nucleic acids of inventions II-VI are related to portions of the nucleotide sequence of SEQ ID NO: 1, however, it is not clearly defined how they are related, and they appear to be different and require separate sequence searches and consideration.

Invention I is unrelated to each of inventions VII and VIII. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the polynucleotides, are physically and functionally distinct chemical entities from the polypeptides and antibodies and have different structures, activities and functions.

Inventions VII and III are unrelated. In the instant case the polypeptides and antibodies are physically and functionally distinct chemical entities that have different structures, activities and functions.

Inventions II-VI are unrelated to each of inventions VII and VIII. In the instant case the

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polynucleotides, are physically and functionally distinct chemical entities from the polypeptides and antibodies and have different structures, activities and functions.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their different classification, recognized divergent subject matter, and/or the need for non-coextensive literature search and/or separate sequence database searches, restriction for examination purposes as indicated is proper.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 C.F.R. § 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 C.F.R. § 1.48(b) and by the fee required under 37 C.F.R. § 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eileen B. O'Hara, whose telephone number is (703) 308-3312. The examiner can normally be reached on Monday through Friday from 10:00 AM to 6:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yvonne Eyler can be reached at (703) 308-6564.

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Official papers Before Final filed by RightFax should be directed to (703) 872-9306.


Official papers After Final filed by RightFax should be directed to (703) 872-9307.

Official papers filed by fax should be directed to (703) 308-4242.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0196.

Eileen B. O'Hara, Ph.D.

Patent Examiner


YVONNE EYLER, PH.D.
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1600